

REMARKS

I. Status and Disposition of the Claims

Prior to the above amendment, claims 1-4, 6-23, and 27-72 were pending, with claims 53-72 withdrawn from consideration by the Examiner as being drawn to a non-elected invention. By the above amendment, claims 1, 20-23, 34, and 43-51 are amended, and claim 2 is cancelled. Accordingly, claims 1, 3, 4, 6-23, and 27-72 are now pending, with claims 53-72 remaining withdrawn from consideration by the Examiner.

Specifically, in an attempt to advance prosecution of this application Applicants have amended claim 1 to remove molybdenum disulfide from the list of particulate materials, and to incorporate the elements of original claim 2 into independent claim 1. Claims 21-23 and 47-51 have been amended so as to depend from claim 1. Finally, claims 34 and 43-46 have been amended to correct a typographical error (i.e., to change "at at" to "at").

Support for these amendments may be found in the as-filed specification and claims, for example, in original claims 1 and 2. Accordingly, these amendments raise no issue of new matter.

In the Office Action, the Examiner:

- withdraws the previous indication of allowable subject matter (Office Action, page 2);
- rejects claims 1, 3, 4, 6-11, 13, 27-30, and 33 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent Nos. 5,364,657 and 5,370,911 ("Throne '657" and "Throne '911" respectfully) (*Id.*);
- rejects claims 1-4, 20-22, 33, and 47-51 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 3,629,028 ("McLarty") (*Id.* at 3);

- rejects claims 34-46 under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as unpatentable over Throne '657, Throne '911, or McLarty (*Id.* at 3-4);
- rejects claims 12, 14-19, 31-32, and 52 under 35 U.S.C. § 103(a) as allegedly unpatentable over Throne '657 and Throne '911 (*Id.* at 4); and
- rejects claims 6-19 and 52 under 35 U.S.C. § 103(a) as allegedly unpatentable over McLarty (*Id.* at 4-5).

Applicants respectfully disagree with and traverse each of these rejections for at least the following reasons.

II. Response to Claim Rejections

A. § 102(b) rejections

As mentioned above, the Examiner rejects various claims under 35 U.S.C. § 102(b) as being anticipated by Thone '657, Throne '911, or McLarty. See Office Action, pages 2-3. Applicants respectfully disagree with and traverse these rejections for at least the following reasons.

To establish anticipation under 35 U.S.C. § 102, an examiner must establish that a reference teaches, either expressly or inherently, each and every element of a claim. See M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. See *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). As discussed below, Throne '657, Throne '911, and McLarty do not anticipate amended claim 1, and thus, any of the pending claims.

Regarding Throne '657 and Throne '911, these references do not disclose, *inter alia*, "a glass fiber product comprising... at least one glass fiber... wherein at least one glass fiber is at least partially coated with a coating, wherein the coating is a residue of a coating composition, wherein the coating composition is selected from a resin-compatible coating composition[.]" as recited in amended claim 1. Applicants also note that amended claim 1 incorporates the elements of original claim 2, which was not rejected by the Examiner under 35 U.S.C. § 102(b). Accordingly, the § 102(b) rejections over Throne '657 and Throne '911 are moot in view of the above amendments.

Regarding McLarty, Applicants submit that McLarty does not anticipate the previously pending claims, much less the currently amended claims. In particular, McLarty does not disclose, *inter alia*, "a glass fiber product comprising...at least one glass fiber... particles adhered to the at least one glass fiber, wherein...the particles have an average dimension ranging from 10 nm to 10 μm ...[.]" as recited in previous (and pending) claim 1. However, to even further distinguish the claimed invention from McLarty, Applicants have removed Molybdenum Disulfide from the list of claimed particulate materials. As a result, McLarty also does not disclose any particulate materials that could fall within the purview of the currently amended claims.

For at least the foregoing reasons, Applicants respectfully submit that Throne '657, Throne '911, and McLarty fail to teach or even suggest each and every element of the pending claims. Accordingly, the applied § 102(b) rejections are improper, and Applicants respectfully request their withdrawal.

B. 35 U.S.C §§102/103 rejections

As noted above, the Examiner rejects various claims under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as unpatentable over one of Throne '657, Throne '911, or McLarty. Office Action, page 3. Inasmuch as much as these rejections are premised on allegations of anticipation under 35 U.S.C. § 102(b) Applicants submit they are improper for the same reasons stated above in section II(A). With respect to the Examiner's allegations of obviousness under 35 U.S.C. § 103(a), Applicants respectfully disagree with and traverse these rejections for at least the following reasons.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) and M.P.E.P. §2141 (Rev. 6, Sept 2007). The Supreme Court in *KSR* also held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141(III) (rev. 6,

Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicants understand this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicants to refute a §103 rejection.

As discussed above, neither the Throne references nor McLarty teach or even suggest a glass fiber product comprising, *inter alia*, the claimed combination of particulate materials and coating composition. Indeed, as discussed above, the Throne references are silent with respect to the claimed coating composition, and McLarty makes no mention of the claimed particulate materials, much less such materials having an average dimension within the purview of amended claim 1. Thus, neither the Throne references or McLarty anticipate any of the pending claims.

Further, the Examiner has not provided evidence in support of, much less even alleged, a tenable rationale that establishes *why* one of ordinary skill in the art would combine or modify the Throne references or McLarty in an attempt to arrive at the claimed invention. For at least these reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to at least claim 1, and thus any claims depending from claim 1. Applicants therefore submit that the applied §§102(b)/103(a) rejections of claims 34-46 are improper, and request their withdrawal.

C. 35 U.S.C. § 103(a) Rejections

Finally, the Examiner rejects various combinations of claims solely under 35 U.S.C. § 103(a) as being unpatentable over one of the two Throne references or

McLarty. Office Action, page 4. Applicants respectfully disagree with and traverse these rejections for at least the following reasons.

First, as discussed above in sections II(A) and (B), the Examiner has not established that the Throne references or McLarty, alone or in combination, anticipate or render obvious a glass fiber product within the purview of amended claim 1. Specifically, the Examiner has not provided a tenable rationale establishing *why* one of ordinary skill would combine or modify the Throne references and/or McLarty in an attempt to arrive at the claimed invention. Moreover, the Examiner has not explained *why* one of ordinary skill would a) modify the Throne references so as to contain the claimed coating composition; b) modify McLarty so as to contain the claimed particles; or c) combine the Throne references and McLarty in such a way in an attempt to arrive at the claimed invention.

Second, Applicants note that in the Office Action, the Examiner casually dismisses elements relating to particle size and shape as being drawn to elements that are "not ordinarily construed to be a matter of invention in the absence of factual evidence to the contrary." Office Action, page 4. However, the Examiner provides no support for this assertion. See *id.* To the extent the Examiner is relying on the case law cited in M.P.E.P. § 2144.04(III), Applicants submit that such reliance is misplaced for the same reasons it was in the prior Office Action, and as explained in Applicants November 15, 2007, Amendment. See *In re Rose*, 220 F.2d 459, 461, 463 (C.C.P.A. 1955) (finding that claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" were not patentable over prior art lumber packages which could be lifted by hand because limitations relating to size were not sufficient to

distinguish over prior art); *In re Rinehart*, 531 F.2d 1048, 1053 (C.C.P.A. 1976) ("[M]ere scaling up of a prior art process . . . would not establish patentability . . ."); *Gardner v. TEC Sys., Inc.*, 725 F.2d 1338, 1345 (Fed. Cir. 1984) (stating that a claimed device is not patentably distinct from prior art that differs only in terms of relative dimensions).

Indeed, careful consideration of this case law reveals that it does not support the Examiner's position. Specifically, each of cases mentioned above (i.e., *In re Rose*, *In re Rinehart*, and *Gardner*), are drawn to the patentability (or lack thereof) imparted by a scale reduction in the size of an entire device. The Examiner has not explained *why* or *how* case law relating to the scale reduction in size of an *entire device* applies to the particles of the present claims, which are components of a larger device. Nor has the Examiner explained why one of ordinary skill would expect that changing the configuration of the particles of the Throne references or McLarty would predictably result in a device that functions in an intended manner, despite such modifications. This is particularly noteworthy, given that particle size is known to have a dramatic impact on at least the solid solubility of particles in a binder, and the fact that the present specification indicates that modification of the dimension of the claimed particles has an impact on the properties of the resultant article. See specification, pages 28-30, paragraphs [091]-[097].

For at least the foregoing reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to any of the pending claims. Accordingly, Applicants submit that the applied 35 U.S.C. § 103(a) rejections are improper, and request their withdrawal.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 5, 2008

By: 

Nikolas J. Uhlig
Reg. No. 62,201
617-452-1682